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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,686	07/13/2001	Hiroyo Masuda	FUJY 18.847	5599
7590 09/12/2005 KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK,, NY 10022-2585			EXAMINER FISCHETTI, JOSEPH A	
			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,686

Applicant(s)

MASUDA ET AL.

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because he claimed invention is directed to non-statutory subject matter. There is no recitation of utilizing a technological arts to effect the steps of calculating and displaying.

112 Rejection

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 as amended is confusing in that:

1. no antecedent basis for "the communication service part".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillis in view of Ehlers et al. and Theil.

Hillis discloses a method of displaying an accounting state for a communication service by a terminal device, comprising steps of receiving a communication service (block 40 user enters number), to which a plurality of accounting methods can be applied (account method for fixed location vs. accounting method for conference call vs. accounting method for ISU to ISU, rates are variable and hence are accounting based results), from a network and providing the communication service for a subscriber; and displaying accounting quantities corresponding to each of said plurality of accounting methods in the process of utilizing the communication service (col. 6 lines 50 et seq. since the displayed rate result of an other accounting practice is shown in the process of its use without deference to any other method, the claim meets this limitation).

But, Hillis fails to disclose an accounting method of each of said plurality of accounting methods differing mutually, calculating accounting quantities during the process of utilizing the device based on the plurality of accounting methods for the communication service part which has been already received.

However, Ehlers et al. disclose displaying (col. 31 lines 28-34) during the use process a rate from one of different rates to calculate the lowest cost as between plural accounting methods, e.g., manual cost entry or manual cost entry, see also, col. 33, line 14, "if selected". It also discloses calculating each supplier's rates on an hour by hour rate see col. 33 lines 1, 2 and calculates using a selected accounting practice. But not

all the results are presented only the lowest cost. But, Thiel does allow all combinations of different accounting method and carries to be displayed to the user for his/her selection col. 10 lines 39 et seq. It would be obvious to modify the device in Hillis to include the display feature of Ehlers et al. which on-going tracks the rates of various carriers and to have each rate calculated with a different accounting method displayable to the user as taught by Thiel the motivation being the ability to see bottom line pricing at the time of usage and to make a change at that point in time.

Re claim 3: the specified accounting quantity is read as the selection in Ehlers et al. between manual cost entry or manual cost entry, the motivation is again herein repeated.

Re claim 7: Hillis disclose notifying the network of pieces of information when he discloses accepting the call at col. 6, line 27, the motivation is again herein repeated.

Claims 1,2,4,5,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillis in view of Ehlers et al. and Thiel as applied to claims 1,3,7 above, and further in view of Kikuchi et al.

Hillis in view of Ehlers et al. and Thiel. disclose the invention substantially as claimed except they fail to disclose the specifics of claims 2,4,5,6. However, Kikuchi et al., re claim 2, disclose obtaining a piece of information on an accounting degree (see unit fee per unit time information 121) corresponding to each of said plurality of accounting methods from said network when the communication service starts being utilized; and measuring, in the process of utilizing the communication service, an quantity of an accounting element corresponding to an accounting method, (speech fee


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process 208) calculating and displaying said accounting quantity (display 212 displays the fee from the calculation made by timer 206). It would be obvious to modify the above combination with the features of Kikuci et al. the motivation being the more efficient procurement of information costs which ultimately results in the lowest fees to be paid by the user.

RE claim 4 it is deemed a mere repetition of steps to calculate and display the fee for various other rates stored in the unit fee database and since these fees while at some point appear on the display 150, they are deemed to have been shown "together".

Re claim 5 and 6, the use of an alarm to sound when a value is exceeded is deemed to be an old and notorious expedient in the art.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.

JOSEPH A. FISCHETTI
PRIMARY EXAMINER


Joseph A. Fischetti
Primary Examiner
Art Unit 3627